



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/625,031 07/25/00 UMEZAWA

BIRCH STEWART KOLASCH & BIRCH LLP
P O BOX 747
FALLS CHURCH VA 22040-0747

IM52/1011

I

2927-0114P

EXAMINER

PATTERSON, M

ART UNIT

PAPER NUMBER

1772

DATE MAILED:

10/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/625,031

Applicant(s)

UMEZAWA, IKUKO

Examiner

Marc A Patterson

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase 'shoes having an outsole including a spike and a projected portion having a ground – contact surface formed thereon' is indefinite; is the projected portion a part of the spike, or a completely different part of the outsole? For purposes of examination, the projected portion will be assumed to be a different part of the outsole. Clarification / or correction is required.

The phrase 'both inclusive' is also indefinite. For purposes of examination, the phrase will be assumed to mean that the lowest and highest numbers in a range are included in the range. Clarification / or correction is required.

The phrase 'set to' is also indefinite. For purposes of examination, the phrase will be assumed to mean 'in'.

The phrase 'cutting time elongation' is also indefinite. For purposes of examination, the phrase will be assumed to mean 'elongation at break'. Clarification / or correction is required.

The phrase 'of a microstructure thereof' is also indefinite. For purposes of examination, the phrase will be assumed to mean 'in the polymer structure'. Clarification / or correction is required.

Art Unit: 1772

The phrase 'rubber - molded' is also indefinite. For purposes of examination, the phrase will be assumed to mean 'rubber'. Clarification / or correction is required.

The phrase JIS - C also renders the claim indefinite, as it is an abbreviation, and also because describes a measuring technique which may change with time. Clarification / or correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 - 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kataoka et al. (U.S. Patent No. 5,533,282) in view Wideman et al. (U.S. Patent No. 5,922,792).

With regard to Claims 1 and 4, Kataoka et al disclose shoes having an outsole (the portion which contacts a surface; column 2, lines 56 - 65) including a spike and a projecting portion having a ground contact surface (column 1, lines 59 - 67 and column 2, lines 1 - 4); the spike and the plate to which it is attached comprise synthetic resin (column 1, lines 12 - 22); the height difference between the spikes and the projecting portion is 4 mm (column 5, lines 17 - 20). Kataoka et al fail to disclose a spike in which the synthetic resin is a rubber - molded material whose JIS - C hardness ranges from 35 to 95, and whose elongation at break is 280% or more, and which contains 30 wt% or more of acrylonitrile - butadiene copolymer.

Wideman et al. teach the use of a rubber composition (column 1, lines 24 – 34) for the making of a shoe sole (column 12, lines 14 – 26) which comprises acrylonitrile – butadiene copolymer (100%; column 3, lines 42 – 53); and has an elongation at break of 672% (which is greater than 280%; column 10, lines 25 – 49) for the purpose of using a rubber having good antifatigue properties (column 1, lines 5 – 9). It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for acrylonitrile – butadiene copolymer (100%; column 3, lines 42 – 53); and has an elongation at break of 672% (which is greater than 280%; column 10, lines 25 – 49) in Kataoka et al in order to use a rubber having good antifatigue properties as taught by Wideman et al..

Wideman et al do not teach a hardness of from 35 – 95, as measured by JIS – C. However, Wideman et al. teach a hardness of 50.5, as measured by sclerometer (Shore hardness; column 10, lines 25 – 48). It would have been obvious for one of ordinary skill in the art to vary the hardness of the rubber, the hardness would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end result. *In re Boesch and Slaney, 205 USPQ 215 (CCPA 1980)*.

With regard to Claim 2, the polybutadiene taught by Wideman et al. contains 100% cis – 1,4 linkage (therefore greater than 70%; column 3, lines 42 – 53).


With regard to Claims 3 and 5, the spike is removably mounted (detachably attached) on the outsole (column 1, lines 11 – 17).

Art Unit: 1772

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (703) 305-3537. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (703) 308-2364. FAX communications should be sent to (703) 305-3599. FAXs received after 4 P.M. will not be processed until the following business day.

M.A.P.


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772 10/9/07